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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,123	12/29/2003	Robert Burnett	139195	9801
24587	7590	02/14/2008		
ALCATEL LUCENT INTELLECTUAL PROPERTY & STANDARDS 3400 W. PLANO PARKWAY, MS LEGL2 PLANO, TX 75075			EXAMINER PASCAL, LESLIE C	
			ART UNIT 2613	PAPER NUMBER
			MAIL DATE 02/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/750,123

**Applicant(s)**

BURNETT ET AL.

**Examiner**

Leslie Pascal

**Art Unit**

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "cross connection" in claim 29 is unclear. It is unclear what the applicant intends for this term to mean from the claim. The accepted meaning of this term is "using a cross connection switching device." The term is indefinite because the specification does not clearly redefine the term. It is unclear from the specification what the applicant means by cross connection. For example, from the beginning of paragraph 19 of the applicants' specification, just connecting the devices forms a cross connection. "The network elements NE1 102 through NE5 110 may be any type of network element performing various wavelength related tasks such as adding wavelengths, dropping wavelengths, regenerating wavelengths and providing for the passage of wavelengths there through, for example. As depicted, wavelengths 112-122, which are respectively labeled  $\lambda_{A}$ ,  $\lambda_{B}$ ,  $\lambda_{C}$ ,  $\lambda_{D}$ ,  $\lambda_{E}$ , and  $\lambda_{F}$ , are transmitted on an optical medium from West to East, i.e., from the direction of NE1 102 to the direction of NE5 110 and from the East to West direction as well in order to form a cross-connection." Although paragraph 21, says "The adjacent NE checks to see if it is inserting the same wavelength back towards the originating NE that provided the wavelength information, i.e., the adjacent NE checks to see if it forms a cross-connection with the originating NE that provided the wavelength information." The applicant gives as the example that the NE checks to see if it forms a cross connection. It does not define cross connection-but merely gives it as an example. It is not clear from the specification what exactly is meant by forming a cross connection (and therefore, determining the cross connection). The specification says that it checks whether the same wavelength is used ... FOR EXAMPLE checks ADJACENT NE to see if it forms a cross connection with the originating NE that provided the wavelength information.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fatehi et al.

In regard to claim 28, Fatehi et al teach a plurality of connection devices (200) which are operable to add, drop and pass wavelengths there through (note the OADM). A first of said devices is operable to insert a wavelength (a source device). This device indicates an address of the source and the wavelength inserted (source address- see column 9, line 65 and wavelength information-see column 9, line 66). The second connection device (another element 200) is operable to insert a wavelength (it also has an OADM). In that the second OADM checks the tag message, it is obvious that it makes a determination of whether the wavelength is "operable" to insert is the same as used by the previous connection device. With regard to claim 29, the applicant claims that the second device determines if the connection with the first device is done with cross connection. See the above 112 problem. The applicant does not appear to have any other details about how the cross connection is determined. Note that each of Fatehi's devices 200 include cross connect devices (according to the well known term for "cross connection" 201 and 203). Although the examiner is not certain what the applicant is trying to claim, from trying to discern what the applicant is trying to claim and using the specification (which still does not make it clear), it would appear that applicant is trying to determine whether two devices are communicating with each other (both sending and receiving information to/from each other). It is well known that two devices would want

to send/receive information with each other in order to carry on two way communication.

In that the data sends information related to both the source and destination in it, it would have been obvious to determine whether two devices could communicate with each other in order to carry out two way communication between the two devices.

Further, see also MPEP 2114:

>While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

See specifically the portion that says that the apparatus must be distinguished from the prior art in terms of structure rather than function.

See also MPEP2111.04:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to " or "adapted for " clauses;
- (B) "wherein " clauses; and
- (C) "whereby " clauses:

In regard to claim 29, the applicant claims a "wherein" clause that "does not limit a claim to a particular structure". In regard to claims 30-31, it appears that the data that is not intended for the device 200 is sent on to a device that it is intended for.

5. With regard to the applicants' arguments, all of the claims are new and have therefore required new legal/ art rejections.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Pascal whose telephone number is 571-272-3032. The examiner can normally be reached on Monday and Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
/Leslie Pascal/  
Primary Examiner  
Art Unit 2613